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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/809,326

03/16/2001

Jon L. Cook

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22852

7590

11/28/2007

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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WASHINGTON, DC 20001-4413

EXAMINER

SALIARD, SHANNON S

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

11/28/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 09/809,326	<b>Applicant(s)</b> COOK ET AL.	
	<b>Examiner</b> Shannon S. Saliard	<b>Art Unit</b> 3628	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42, 44-85 and 87-100 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 17-42, 44-53, 60-85, 87, 88, 91-95 and 98-100 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-16, 54-59, 89, 90, 96 and 97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/24/07, 6/25/04, 9/1/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of Group III (Claims 11-16, 54-59, 89, 90, 96, and 97) in the reply filed on 24 August 2007 is acknowledged.
2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. **Claims 13 and 56** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **claims 13 and 56**, the limitation "wherein the static address database is a United States Postal Service static monolithic address database" is vague and indefinite. Monolithic is defined as unified or solid. Based on this meaning, it is unclear to the Examiner what "monolithic" means as used in the claimed limitation.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 11-16, 54-59, 89, 90, 96, and 97** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky et al [US 6,285,777].

As per **claims 11, 14, 54, 57, 89, 90, 96, and 97**, Kanevsky et al discloses a method for determining a standardized physical address of a user with an electronic account of the user, comprising the steps of [col 6, lines 29-34]:

creating a static address database from a master address database, the static address database containing the standardized physical address of the user [col 5, line 49-col 6, line 8],

wherein the standardized physical address comprises a predetermined set of data [see fig. 5 and descriptions thereof];

obtaining an address of the user from the electronic account [col 5, lines 44-49];

sending the address of the user to the static address database [col 5, lines 55-59]. Kanevsky et al does not explicitly disclose receiving a delivery point identification key corresponding to the address of the user, wherein the delivery point identification key can be used to obtain the standardized physical address of the user from the static address database. However, Kanevsky et al discloses that a header contains identifying information to determine a corresponding address associated with a register e-mail address for use in mailing an item [col 6, lines 29-34; col 2, lines 59-62; col 3, lines 16-24; Examiner interprets key to be any info for determining address]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Kanevsky et al to include receiving a delivery point identification key corresponding to the address of the user, wherein the delivery point identification key can be used to obtain the standardized physical address of the user from the static address database to determine how to handle the mail as suggested by Kanevsky et al [col 2, lines 55-65].

As per **claims 12 and 55**, Kanevsky et al discloses wherein the master address database is a United States Postal Service master address database [col 3, lines 59-61].

As per **claims 13 and 56**, Kanevsky et al further discloses wherein the static address database is a United States Postal Service static monolithic address database [col 3, lines 59-61].

As per **claims 15 and 58**, Kanevsky et al further discloses wherein the address database contains a plurality of standardized addresses corresponding to a plurality of users, each standardized address conforming to a standard format [col 6, lines 1-4].

As per **claims 16 and 59**, Kanevsky et al further discloses wherein the standard format includes a street and city [see Fig. 5]. Kanevsky et al does not disclose wherein the standard format includes street number, street name, city, state, and ZIP code. However, it is old and well known at the time of the invention that a standard address of a user contains street number, street name, city, state, and ZIP code. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Kanevsky et al to include wherein the standard format includes street number, street name, city, state, and ZIP code to facilitate mail identification.

### ***Conclusion***

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shannon S. Saliard whose telephone number is 571-272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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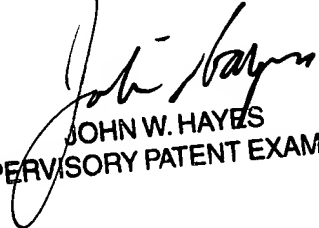
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Hand delivered responses should be brought to the Customer Service Window,  
Randolph Building, 401 Dulany Street, Alexandria, VA 22314

Shannon S Saliard  
Examiner  
Art Unit 3628

SSS

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER